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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/992,937      | 11/05/2001  | Marcus Gilford Lashley | 1013-3              | 9156             |

7590 03/08/2004

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| EXAMINER |
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CHIANG, JACK

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2642     |              |

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/992937

Applicant(s)

Lashley

Examiner

J. Chiang

Group Art Unit

2642

4

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11-05-01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

## **CLAIMS**

### **Double Patenting Rejection**

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6314185. Although the conflicting claims are not identical, they are not patentably distinct from each other because the features of the cover, and the base and cap in the present application are all substantially claimed in the patent above.

### **112 First Paragraph Rejection**

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 1, lines 7-8, it claims "... said peripheral section ... rolled up into a roll in a direction away from a center of said central section...". This is questionable because from a cup shape (fig. 2) to a flat shape (fig. 1), the peripheral section has to be rolled up into a roll in a direction TOWARD a center of said central section, not AWAY.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Secher (US 5706926) in view of Ordway (US 644680) or a condom (no paper document is provided).

Regarding claim 1, Secher shows a sanitary cover (2) comprising:

A central section having at least one perforation (see 12);

A peripheral section (side 4) being made of a layer of flexible material (col. 3, lines 66-67); and

The central and peripheral sections cover a phone section (figs. 4 and 10).

Secher differs from the claimed invention in that it is not rolled up when packaging the cover.

However, Ordway teaches a concept of rolling the cover (col. 2, lines 30-31). Further, the examiner has referred to Secher's type of sanitation cover as a "phone condom" for many years, because the design of such phone cover is looked like a "condom", and the

function of such phone cover is to prevent transmission of diseases, this is also similar to the function of the condom.

Therefore, it would have been obvious for one skilled in the art to package Secher's phone cover (condom) by rolling up the cover as taught by Ordway or the notorious method of packaging a condom, because all these products are substantially similar in design and function, such packaging method of rolling up the cover is a conventional way of packaging and marketing such covers.

Regarding claims 2-7, the combination of Secher shows:

The central section and the peripheral section (2) are made of a flexible material (col. 3, lines 66-67) which can be rolled (see comments in claim 1);

The flexible material (col. 3, lines 66-67) is a plastic which is generic for latex, rubber etc.;

The covering of a microphone and a speaker of a phone (fig. 10);

A connection device (6) which is positioned with the peripheral section (side 4); and

6. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Secher and Ordway/condom in view of Peck (US 961369).

Regarding claims 8-11, the combination of Secher shows the cover and the connection device (2, 6 in Secher).

The combination differs from the claimed invention in that it does not have a connection device in the form of a c-shaped ring.

However, Peck, in a sanitation cover, teaches providing a connection device (14) for connecting the cover (11-13, 16-18) onto an object.

Hence, from various methods of mounting the cover on the object shown by the present application, such as the direct mounting of the cover, or a c-shaped ring, or the base/cap, it can be seen that there are various methods of mounting the cover. Further, the concept of attaching the cover onto the object is well taught by Secher, Ordway and Peck, therefore, it would have been obvious for one skilled in the art to adapt Peck's method on the mounting of Secher by using a c-shaped ring, this can be considered as a method to reenforce the mounting of Secher, or it can be considered as a variation of Secher because the basic concept of mounting the cover onto the object is substantially unchanged.

7. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Secher and Ordway/condom in view of Lemley (US 4819264).

Regarding claims 12-15, the combination of Secher shows the cover (2).

The combination differs from the claimed invention in that it does not have a base and a cap for mounting the cover.

However, Lemley teaches providing a plastic base and cap (50, 48) having a protrusion/groove (68, 70; 58, 60) for mounting a cover onto the phone.

Hence, it would have been obvious for one skilled in the art to directly mount the cover on the phone as taught by Secher (this is also taught by Lemley's figs. 6-7), or using a base and cap for mounting the cover as taught by Lemley, this simply can be

considered as an alternative method of mounting the cover and would be considered as a variation of Secher, because the basic concept of mounting the cover onto the phone is substantially the same.

8. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Secher and Ordway/condom in view of Lo (US 5054063).

Regarding claims 16-20, the combination of Secher shows the cover.

The combination differs from the claimed invention in that it does not explicitly mention that disinfectant is also applied onto the cover.

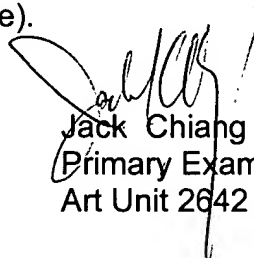
However, Lo, in the same field of endeavor as Secher, teaches providing a cover with has disinfectant.

Hence, it would have been obvious for one skilled in the art to modify the combination of Secher by providing disinfectant on the cover with/without the teaching of Lo, such that to deter the propagation of bacteria and other germs, a concept of reinforcing the protection function of the cover (col. 1, lines 43-45 in Lo). Further, the various method of applying the disinfectant onto the cover can be considered as a variation of the combination, and it is also dictated by the types of disinfectant possessed by the user.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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